

REMARKS

Claims 1, 4, 5, 7, 8, 12, 15, 16, 18, 19, 23, 26 and 27 are rejected under 35 U.S.C. §102(b) as being anticipated by *Lipner et al.* (U.S. Patent 5,557,346). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Independent claims 1, 12 and 23 include:

“generating a session key;
encrypting the data utilizing the session key using a symmetric encryption routine;
encrypting the session key utilizing a user public key using a first asymmetric encryption routine;
encrypting the session key utilizing a master public key using a second asymmetric encryption routine;
generating a data packet including the encrypted data, the encrypted session key utilizing the user public key and the encrypted session key utilizing the master public key;
transmitting the data packet to a destination data processing system;
decrypting the data packet utilizing the session key using the symmetric encryption routine;
decrypting the session key utilizing a user private key using the first asymmetric encryption routine; and
decrypting the encrypted session key utilizing a master private key using the second asymmetric encryption routine.”

The PTO provides in MPEP §2131...“To anticipate a claim, the reference must teach every element of the claim...”. Therefore, to sustain this rejection the *Lipner et al.*

patent must contain all of the claimed elements of claims 1, 12 and 23. However, the claimed specific routines, i.e. symmetric, first asymmetric and second asymmetric are not shown or taught in the *Lipner et al.* patent. It is not just the use of symmetric and asymmetric routines, but it is the specific arrangement of those routines used in a specific sequence for encrypting and decrypting which is novel. Therefore, the rejection is unsupported by the art and should be withdrawn.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 9, 10, 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Lipner et al.* as applied to claims 1 and 12 above, and further in view of *Dillaway et al.* (U.S. Patent No. 5,742,756).

Claims 11, 22 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Lipner et al.* as applied to claims 1, 12 and 23 above, and further in view of *Kruys* (U.S. Patent 5,555,309).

Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner

must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The cited references fail to disclose the claimed invention. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because none of the cited references teach or even suggest the desirability of the combination claimed in the dependent claims and their respective independent claims. Moreover, none of the cited references provide any incentive or motivation supporting the desirability of the combination. These references do not achieve a combined teaching or suggestion of: generating a session key; encrypting the data utilizing the session key using a symmetric encryption routine; encrypting the session key utilizing a user public key using a first asymmetric encryption routine; encrypting the session key utilizing a master public key using a second asymmetric encryption routine; generating a data packet including the encrypted data, the encrypted session key utilizing the user public key and the encrypted session key utilizing the master public key; transmitting the data packet to a destination data processing system; decrypting the data packet utilizing the session key using the symmetric encryption routine; decrypting the session key utilizing a user private key using the first asymmetric encryption routine; and decrypting the encrypted session key utilizing a master private key using the second asymmetric encryption routine."

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 15.72, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in

the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1, 12 and 23 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1, 7-12, 18-23 and 29 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.


Respectfully submitted,



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